

### **REMARKS**

The Office Action of March 10, 2004 has been reviewed and the comments therein were carefully considered. Claims 1-35 are currently pending, and claims 1-35 stand rejected. No new matter has been introduced into the application. Applicants respectfully request reconsideration of the application and allowance of all pending claims.

#### **Rejections under 35 USC § 103**

Claims 1-7, 9, 12-13, 16-23, and 32-35 are rejected under 35 USC § 103(a) as being unpatentable over *Murashita*, U.S. Pat No. 6,330,574 filed 03/30/1998 ("*Murashita*"), in view of "*Open eBook* Publication Structure 1.0" (hereafter referred to as *Open eBook*) published 09/16/1999. Applicants respectfully traverse these rejections.

Claim 1 recites:

A method for encoding an electronic document having markup language content, wherein the document includes at least one tag and an associated content, the method comprising the steps of:

- (a) separating the tag from the content with a separation variable;
  - (b) replacing the tag with an alias, wherein the alias is a pre-defined representation for the tag; and
  - (c) inserting at least one flag within the tag to form an encode tag structure,
- wherein a first encoded document is formed.

Applicants submit that claim 1 is allowable over the cited art for at least the following reasons. The combination of *Murashita* and *Open eBook* fails to teach at least the claimed element of "separating the tag from the content with a separation variable" as recited in step (a) of claim 1. *Murashita* does not separate a tag from content, using a separation variable, but rather extracts the

tag from the file using a tag extracting unit. There is no indication in *Murashita* that this tag extraction tool operates in such a way as to separate a tag from content “with a separation variable.” *Open eBook* does not cure this deficiency in *Murashita*. As a result, Applicants respectfully submit that claim 1 is allowable over the cited references for at least this reason.

In addition, claim 1 is allowable over *Murashita* and *Open eBook* for at least one additional reason. The combination of *Murashita* and *Open eBook* fails to teach or suggest “inserting at least one flag within the tag to form an encode tag structure” as recited in claim 1. The office action states and Applicants agree that *Murashita* fails to teach “inserting at least one flag within the tag to form an encode tag structure.” Section 2.2 lines 7-12 of the *Open eBook* publication states:

The x-metadata element must contain one or more instances of a meta element, analogous to the HTML 4.0 meta element, but applicable to the publication as a whole. The x-metadata element allows content providers to express arbitrary metadata beyond the data described by the Dublin Core language. Individual OEB documents may include the meta element directly (as in HTML 4.0) for document-specific metadata. This specification uses the OEB package file alone as the basis for expressing publication-level Dublin Core metadata.

Although the cited section discloses that x-metadata allows content providers to express arbitrary metadata beyond the data described by the Dublin Core language, the cited section does not address the claimed limitation of “inserting at least one flag within the tag to form an encode tag structure.” Allowing content providers to express arbitrary metadata does not disclose, teach or suggest “inserting at least one flag within the tag to form an encode tag structure.” The office action further states:

[T]he ability of *Open eBook* to use x-metadata, described in section 2.2 would have allowed one of ordinary skill in the art to have used the metadata to improve the computational ability of the document improving such electronic book features such as browsing and searching capabilities.

Office Action, page 13. However, the above cited section does not address the claimed feature of

“inserting at least one flag within the tag to form an encode tag structure.” Therefore, for at least this additional reason, Applicants submit that claim 1 is in condition for allowance. Dependent claims 2-9 which ultimately depend from claim 1 are allowable for at least the same reason as independent claim 1.

Claim 12 and 13 also stand rejected under *Murashita* in view of *Open eBook*. Applicants submit that these claims are allowable because the combination of *Murashita* and *Open eBook*, even if proper, fails to teach or suggest each of the claimed features of claim 12. Claim 12 recites in relevant part:

- (b) determining whether the portion is to be displayed for viewing by a reading device; and
  - (c) if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion,
- whereby a no search field may be readily identified and skipped during a run-time linear search.

The office action states and Applicants agree that *Murashita* does not teach or suggest steps (b) or (c) of the claim. The office action relies on *Open eBook*, contending that at section 3.3, *Open eBook*, shows “determining whether the portion is to be displayed for viewing by a reading device.”

Office Action, page 5. Section 3.3 of *Open eBook* reads:

### 3.3 Rendering on Limited Reading Systems

A number of elements and attributes below permit semantics that are not required of all OEB reading systems. For example, some devices may be monochrome, or provide mainly audio or tactile interfaces. In such cases this specification generally requires reading systems to accept all syntax (such as attribute values) permitted for the HTML construct, but does not require that they be honored. For example, a reading system must parse and recognize the *border* attribute on *table* elements, but may choose to treat all values other than 0 the same as 1.

Note that this specification does not mandate specific rendering behavior for the HTML constructs. Some reading systems may choose to express the intent of elements in presentation by closely

following web-browser usages – a blank line before a paragraph, but no first-line text-indent, for example. Other reading systems may gear their presentation towards sustained novel-like readability: for example, no extra whitespace between paragraphs, but text-indent on the first line of each. Still other systems, such as speech generators, may present particular elements or entire documents in completely different ways.

Tellingly, at no point in this section does the *Open eBook* describe “determining whether the portion is to be displayed for viewing by a reading device” as recited in the claim. Rather, this portion of *Open eBook* merely describes that different reading devices may have different capabilities, and that rendering behavior may differ between these devices. It does not, however, teach or suggest the claimed element of “determining whether the portion is to be displayed for viewing by a reading device.”

In addition, the combination of *Murashita* and *Open eBook* also fails to teach or suggest “if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion” as recited in claim 12. The office action states and Applicants’ agree that *Murashita* does not teach “if the portion is not to be displayed for viewing, inserting a no search flag in association with the portion.” Office Action, page 7, lines 4-5. The Office Action further states that *Open eBook* does teach (at section 2.2 lines 7-12) the claimed feature of “inserting a no search flag in association with the portion.” The Applicants respectfully disagree, as allowing a content provider to express arbitrary metadata does not disclose the claimed feature of claim 12. Therefore, for at least these reasons, Applicants submit that claim 12 is in condition for allowance. Dependent claim 13 which ultimately depends from claim 12 is allowable for at least the same reasons as independent claim 12.

Claim 16 also stands rejected under *Murashita* in view of *Open eBook*. The office action states that *Murashita* teaches “locating a tag within an electronic document associated with a portion

of content at column 3, lines 17-19 and Figure 3.” Office Action, page 5. The office action further contends that *Murashita* teaches “identifying a pre-defined integer alias for the tag in column 3, lines 19-22”, and replacing the tag with the alias at column 3, lines 22-24 and at Figure 3.” Office Action, page 5. Applicants respectfully traverse. Claim 16 recites:

A method for encoding an electronic document comprising the steps of:

- (a) inserting at least one code character into the electronic document to separate markup language from content;
- (b) locating a tag within the electronic document associated with a portion of content;
- (c) identifying a pre-defined integer alias for the tag; and
- (d) replacing the tag with the alias,

whereby the tag may be readily identified during run-time parsing of the document.

The office action admits that *Murashita* does not explicitly teach inserting at least one code character into the electronic document to separate markup language from content, but instead alleges that *Murashita* teaches separating markup language from content at Figures 32 and 33, and inserting code characters into the electronic document in the abstract of the invention, and further at column 3, lines 7-42. The office action goes on to contend that *Murashita* teaches discriminating between tags and document content from column 3, line 51 to column 4, line 6. According to the office action, it would have been obvious to one of ordinary skill in the art to modify *Murashita* to achieve the claimed invention because it would have been obvious and desirable to have inserted code characters before and after the tags so that the discriminating unit could have determined which portions of the document were content items and which parts of the document were markup language tags. Applicants submit that *Murashita* fails to teach, suggest or otherwise disclose the claimed feature of “inserting at least one code character into the electronic document to separate markup language from content.” At most, *Murashita* describes a tag discriminating unit which determines whether data in

the document instance of an SGML document is a tag or not. Col. 15, lines 28-31.

Moreover, the modification proposed by the office action to achieve “inserting at least one code character into the electronic document to separate markup language from content” is improper because it engages impermissible hindsight. The office action improperly uses the result of the modification *Murashita* as the motivation for the modification of *Murashita*. There must be some suggestion in the prior art reference that shows that it would be somehow desirable to modify the reference. The office action points to no such suggestion. In responding at page 12 to a previous argument made with respect to claim 16, the office action merely offers the conclusory statement that “it would have been an obvious modification to one of ordinary skill in the art at the time of the invention to have inserted at least one code character into an electronic document to separate markup language from content.” The Applicants respectfully submit that no other reason is offered as to why a person of ordinary skill in the art would be motivated to make such a modification. Applicants submit that no such motivation is present in *Murashita*. Therefore, for at least this reason, it is respectfully submitted that independent claim 16 is in condition for allowance. Claims 17 and 18 depend from claim 16 and are also allowable as being dependent on an allowable base claim.

Moreover, with respect to claim 17, Applicants submit that *Murashita* lacks any teaching or suggestion of “an attribute type within a tag” as recited in the claim. Claim 17 recites:

The method of encoding of claim 16, further comprising the steps of:

- (e) locating an attribute type within the tag;
- (f) identifying a pre-defined attribute alias for the attribute type; and
- (g) replacing the attribute type with the attribute alias.

As explained in the specification at page 16, line 20:

Similarly, attributes can be identified by integer codes. Any coding scheme may be implemented for the attribute types. In one preferred embodiment where the e-book has HTML content, the attribute codes may be taken from an IE 5.0 web browser header file, namely the

header file MSHTMDID.H. HTML attribute codes are the DISPIDs (dispatch identifiers) exposed by the programming model for the IE 5.0 web browser. For example, the tag <p align="left">, has an attribute "align." This attribute is identified by code STDPROPID\_XOBJ\_BLOCKALIGN in the IE 5.0 web browser header file.

*Murashita* does not disclose "an attribute type" as claimed in dependent claim 17 and as provided for in the specification. Thus, for this additional reason, claim 17 is allowable.

Claim 19 also stands rejected under *Murashita*. The office action alleges that *Murashita* teaches at least one tag having encoded therein a predefined integer alias for a tag at column 3, lines 17-22. The office action further alleges that *Murashita* discloses a content portion associated with a tag at column 3, lines 12-17 and a code separating a tag from content at column 3, lines 22-24. Claim 19 is drawn to a computer readable medium having stored thereon a markup language document comprising in combination the claimed feature of "a code separating the tag from the content portion." Applicants respectfully traverse the rejection.

As stated above with respect to independent claim 16, *Murashita* at most describes a tag discriminating unit which determines whether data in the document instance of an SGML document is a tag or not. Col. 15, lines 28-31. *Murashita* does not disclose "a code separating the tag from the content portion." Therefore, for at least this reason, it is respectfully submitted that independent claim 19 is in condition for allowance. Dependent claims 20-23 depend from claim 19 are allowable for at least the same reason as independent claim 19. In addition, as stated in connection with claim 16 above, *Murashita* lacks any teaching or suggestion that it would be desirable to modify the reference to include providing a code separating the tag from the content portion as recited in claim 19. Thus, because *Murashita* fails to disclose a code for separating the tag from the content portion, and *Open eBook* does not cure this deficiency, claim 19 is allowable.

Claim 32 also stands rejected under the *Murashita* and *Open eBook*. Independent claim 32

includes the claimed feature of “forming a converted document, wherein the converted document has a file format comprising in combination: i) a root directory; and ii) a content directory . . . .” The office action alleges that *Murashita* teaches forming a converted document, but it does not teach comprising a root directory and a content subdirectory having nested therein at least one linked content file providing content information relating to the converted document linked to the root directory. The office action then states that “*Open eBook* does teach forming a converted document comprising a root directory and a content subdirectory . . . .”

Applicants’ respectfully disagree as the *Open eBook* document does not disclose the claimed feature of “a content subdirectory linked to the root directory, the content subdirectory having nested therein at least one linked content file providing content information relating to the converted document” as recited in claim 32. The *Open eBook* document describes a structure for representing the content of electronic books. However, nowhere in *Open eBook* does it teach or suggest that a converted document comprise a root directory and a content subdirectory as recited in the claim. In fact, *Open eBook* does not address directory structure at all. Rather, it merely discusses nesting tags and elements within a single file or tag structure. Therefore, for at least these reasons, Applicants submit that claim 32 is in condition for allowance. Dependent claims 32-35 which ultimately depend from claim 32 are allowable for at least the same reason as claim 32.

Claims 24-31 are rejected under 35 USC § 103(a) as being unpatentable over “*Open eBook* Publication Structure 1.0” (hereafter referred to as *Open eBook*) published 09/16/1999 in view of *Murashita*, US 6,330,574 filed 03/30/1998. Applicants respectfully traverse for at least the following reasons.

Applicants submit that that *Open eBook* fails to teach or otherwise suggest the claimed feature of “a root directory” and “a content subdirectory linked to the root directory, the content



subdirectory having nested therein at least one linked content file providing content information relating to the electronic book, wherein the content file is pre-computed and encoded to minimize computational run-time requirements” as recited in the claim.

As discussed above with respect to claim 32, *Open eBook* fails to provide any discussion of directory structure or linked content files. Although it discusses nesting tags and elements, it does not discuss a root directory or a content subdirectory as recited in claim 24. Thus, Applicants submit that claim 24 is allowable. Claims 25-31 depend from claim 24 and are also allowable as being dependent on an allowable base claim and further in view of additional novel features recited therein.

Claims 10 and 11 are rejected under 35 USC § 103(a) as being unpatentable over “*Open eBook Publication Structure 1.0*” (hereafter referred to as *Open eBook*) published 09/16/1999 in view of *Kucera*, et al. (hereafter referred to as *Kucera*), US 4,864,502. Applicants respectfully traverse.

Claim 10 recites:

A method for pre-computing an electronic document having markup language content comprising the steps of:

- (a) identifying a tag between a left and a right term within a document;
- (b) determining whether the tag is within a single word; and
- (c) if the left and right terms are not part of a single word, inserting a word break flag between the left and right term,

whereby a word break may be readily identified during a run-time search operation.

In response to Applicants previous argument that *Open eBook* and *Kucera* do not teach alone, or in combination step (c) of the claim, the office action states that it would have been obvious to one of ordinary skill in the art to have used the metadata ability of *Open eBook* to have placed a word break flag to separate two distinct words. Applicants submit that such a modification is in no way suggested by *Open eBook*. Section 2.2 lines 7-12 of *Open eBook* are simply inapplicable to inserting

a word break flag between a left and right term. A generalized ability to insert metadata elements into an *Open eBook* tag is not suggestive of the claimed feature of “if the left and right terms are not part of a single word, inserting a word break flag between the left and right term” as recited in claim 10. Accordingly, Applicants respectfully submit that claim 10 and dependent claim 11 are each allowable over the cited references.

Claims 14 and 15 are rejected under 35 USC § 103(a) as being unpatentable over “*Open eBook* Publication Structure 1.0” (hereafter referred to as *Open eBook*) published 09/16/1999 in view of *Edelman*, et al. (hereafter referred to as *Edelman*), US 6,442,576 B1 filed 08/06/1997. Claim 14 recites in relevant part:

A method for pre-computing an electronic document having markup language content comprising the steps of:

- (a) identifying a Uniform Resource Locator (URL) within a document;
- (b) searching a manifest file for a file referenced by the URL; and
- (c) if the file is identified in the manifest file with a reference string, replacing part of the URL with the reference string and a flag for the file,

whereby the file referenced by the URL may be readily accessed when selected during run-time.

Applicants respectfully submit that the combination of *Open eBook* and *Edelman* do not disclose, teach, or suggest the claimed feature of “replacing *part* of the URL with the reference string and a flag for the file.” *Edelman* does not teach replacing *part* of a URL with a reference string and a flag as recited in claim 14. (Emphasis added). Rather, *Edelman* shows replacing an entire element with another element. For example, at column 2, lines 37-38 *Edelman* states: “The apparatus can also replace the found element with a substitute element.” Nowhere in *Edelman* is found any discussion of “replacing part of the URL” as recited in claim 14. Therefore, for at least this reason, Applicants respectfully submit that independent claim 14 is in condition for allowance. Dependent

claim 15 which ultimately depends from claim 14 is allowable for at least the same reason as independent claim 14.

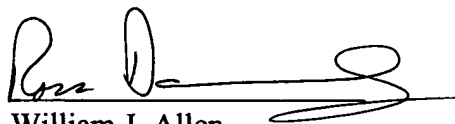
Claim 8 is rejected under 35 USC § 103(a) as being unpatentable over *Murashita*, US 6,330,574 filed 03/30/1998, in view of “*Open eBook Publication Structure 1.0*” (hereafter referred to as *Open eBook*) published 09/16/1999 as applied to claim 1 above, and further in view of *Edelman*, et al. (hereafter referred to as *Edelman*), US 6,442,576 B1 filed 08/06/1997. Applicants submit that claim 8 is allowable as being dependent on an allowable base claim 1.

### **CONCLUSION**

The Applicants respectfully submit that the instant application is in condition for allowance. Should the Examiner believe that a conversation with Applicant's representative would be useful in the prosecution of this case, the Examiner is invited and encouraged to call Applicant's representative.

Respectfully submitted,

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